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Docket No. 258970US0X PCT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Nozomu SUGO, et al.

SERIAL NO: 10/509,087

GAU: 1754

FILED: September 28, 2004

EXAMINER:

FOR: METHOD FOR MANUFACTURING ACTIVATED CARBON, POLARIZABLE ELECTRODE, AND ELECTRIC DOUBLE-LAYER CAPACITOR

INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.97

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicant(s) wish to disclose the following information.

REFERENCES

- The applicant(s) wish to make of record the reference(s) cited in the attached Australian Office Action and listed on the attached form PTO-1449. Copies of the listed reference(s) are attached, where required, as are either statements of relevancy or any readily available English translations of pertinent portions of any non-English language reference(s).
- A check or credit card payment form is attached in the amount required under 37 CFR §1.17(p).

RELATED CASES

- Attached is a list of applicant's pending application(s), published application(s) or issued patent(s) which may be related to the present application. In accordance with the waiver of 37 CFR 1.98 dated September 21, 2004, copies of the cited pending applications are not provided. Cited published and/or issued patents, if any, are listed on the attached PTO form 1449.
- A check or credit card payment form is attached in the amount required under 37 CFR §1.17(p).

CERTIFICATION

- Each item of information contained in this information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.
- No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this statement.

DEPOSIT ACCOUNT

- Please charge any additional fees for the papers being filed herewith and for which no check or credit card payment is enclosed herewith, or credit any overpayment to deposit account number 15-0030.

Respectfully submitted,

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Your Ref: P24636AU00

Examiner's first report on patent application no. 2003227354
by Kuraray Chemical Co., Ltd and Honda Giken Kogyo Kabushiki Kaisha

Last proposed amendment no.

Dear Madam/Sir,

I am replying to the request for examination. I have based this report on the verified translation. I have examined the application and I believe that there are lawful grounds of objection to the application. These grounds of objection are:

1. There is no Notice of Entitlement on file. You will need to file one because an application without a Notice of Entitlement cannot be accepted.
2. The specification does not comply with Section 40(4). The independent claims do not relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

The considerations under sec 40(4) as to whether there is more than one invention claimed are the same as for lack of unity under Rule 13 of the PCT Regulations. PCT Rule 13.2, first sentence, states that unity of invention is only fulfilled when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. PCT Rule 13.2, second sentence, defines a special technical feature as a feature which makes a contribution over the prior art.

The only feature common to all of the claims appears to be the mixing of carbonaceous material with an alkali metal compound. However this concept is not novel in the light of:

- D1. EP 1 103 523
D2. EP 1 176 617 *121180 9-28-4*
D3. JP 11-349320
D4. JP 2002-043189
D5. JP 2002-043190 *121180 9-28-4*

This means that the common feature can not constitute a special technical feature within the meaning of PCT Rule 13.2, second sentence; since it makes no contribution over the prior art. Because the common feature does not satisfy the requirement for being a special technical feature it follows that it cannot provide the necessary technical relationship between the identified inventions. Therefore the claims do not satisfy the requirement of unity of invention *a posteriori*.

3. Claims 30-47 do not fully define the invention described because they omit the feature of the carbonaceous material and the alkali metal compound being treated under solid state conditions, which from reading the specification as a whole, appears to be essential to the invention.
4. Claim 1 is not clear because of the term "solid state". It is unclear whether this term refers to the carbonaceous material and/or the alkali metal hydroxide. However, the term "carbonaceous material" would appear to encompass non-solid materials such as liquid petroleum.
5. Claim 1 is not clear because I cannot find an antecedent to the terms "the mixture", "the granules", "the dehydration product" within the claim.
6. Claim 25 is not clear because of the phrase "had finely been pulverised". It is assumed that the phrase was intended to define "had been finely pulverised".
7. Claim 28 is not clear because I cannot find an antecedent to the terms "the mixture", "the granulated substance", "this dehydration product", "the surface layer region" and "the center portion" within the claim.
8. Claim 30 is not clear because I cannot find an antecedent to the terms "the standard deviations", "the relative peak strengths", "the graphite D band", "the amorphous G band" and "the Raman spectrum" within the claim.
9. Claims 2, 3, 4, 5, 6, 7, 16, 22, 24, 26, 32, 33, are not clear because I cannot find an antecedent to one or more of the terms "the granulation treatment", "the dehydration treatment", "the granulation product", "the rate at which the temperature is raised", "the holding time", "the carbon material", "the system", "the metal" and "the iron, copper, and nickel". Due to the large number of antecedence issues, it is possible that other claims may also contain terms that lack an antecedent.
10. Claims 38 and 39 are not clear because of the phrase "a step for using the molded product to perform the heating process of the activation treatment". It is unclear how the molded product performs the heating process of the activation treatment. It is assumed that the phrase is intended to define that the activation treatment is provided by the heating performed during the molding process.

NOTE: As a consequence of the lack of unity objection I have restricted the examination of novelty and inventive step to the invention listed in claims 1-27 and comment on the novelty and inventive step of any claims relating to further inventions is withheld pending the applicant's response to this report. However, with regard to the issues of novelty and inventive step of claims 28-47, the Applicant's attention is directed to the prior art cited in the lack of unity objection.

11. The invention defined in claims 1-27 is not novel and/or not inventive when compared with the following prior art documents:

- D1. EP 1103523
- D2. EP 1176617
- D3. JP 11-349320
- D4. JP 2002-043189
- D5. JP 2002-043190

In particular, D2 discloses a process for preparing activated carbon comprising the steps of mixing a carbonaceous material (eg isotropic pitch) and an alkali metal hydroxide (eg KOH), a granular mixture that is dehydrated prior to activation (see paragraph [0035] and Example 11).

You have 21 months from the date of this report to overcome all my objection(s) otherwise your application will lapse.

You will need to pay a monthly fee for any response you file after 12 months from the date of the first report.

You will also need to pay any annual continuation fees that apply. These will normally be first due five years from the filing date. Please note however that earlier commencement dates apply for divisional applications.

Information about fees may be obtained by phoning 1300 651010.

Yours faithfully,

RANDALL ENGLISH
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